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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/870,258

05/30/2001

Robert E. Krancher

1662-36600 JMH
(P00-3414)

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04/06/2004

EXAMINER

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ART UNIT

PAPER NUMBER

2111

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/870,258	KRANCHER ET AL.	
	Examiner	Art Unit	
	Khanh Dang	2111	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 27-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27 and 28 is/are allowed.
- 6) ☒ Claim(s) 1-12, 19-23, and 29-37 is/are rejected.
- 7) ☒ Claim(s) 13-18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 12-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 12, the phrase "transferring information about software" (lines 4 and 6) is unclear in view of the specification. From the specification, determination on the issue of compatibility is "software executed."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12, 19-23, and 29-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Lin et al.

At the outset, it is noted that similar claims will be grouped together to avoid repetition in explanation. In addition the explanation set forth below, Applicants'

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attention is also directed to additional explanation provided under "Response to Arguments."

As broadly drafted, these claims do not define any structure that differs from Lin et al. With regard to claims 1-3, Lin et al. discloses a computer system comprising: a notebook computer (laptop L) having an expansion bus (PCI bus); a docking station (expansion base E) having an expansion bus (PCI bus); and a communication pathway (serial I2C) coupling the notebook computer (L) and the docking station (E); wherein each of the notebook computer and docking station communicate across the communication pathway (serial I2C) to determine whether the notebook computer and docking station are compatible devices (by using at least EEPROM 151 and microcontroller 170) prior to coupling the expansion bus of the notebook computer to the expansion bus of the docking station. With regard to claims 4 and 5, the notebook computer (L) further comprises: a microprocessor (100); a system main memory (106); a first bridge logic device (104, for example) coupling said microprocessor and system main memory; a second bridge logic device (118, for example) coupled to the first bridge logic device by way of a primary expansion bus (PCI bus); a notebook docking connector (switches/connector in Lin et al.) coupled to the bus bridge by way of the expansion bus (ISA bus, for example) of the notebook computer, the expansion bus being a secondary expansion bus; an input/output device (124, for example) coupled to the second bridge logic device (118) by way of a secondary expansion bus (ISA bus, for example), and wherein the input/output device is configured to communicate across the communication pathway (I2C) to determine whether the docking station (E) is

compatible with the notebook computer (L); and wherein the communication pathway (I2C) is a notebook computer serial bus coupled between the docking connector and the input/output device. With regard to claims 6 and 7, the docking station further comprises: a docking station docking connector (146); a bus bridge (MISC-E 118) coupled to the docking station docking connector, wherein the bus bridge bridges the secondary expansion bus of the notebook computer to an expansion bus (PCI 112B) of the docking station; a docking station serial bus (I2C) coupled to the docking station docking connector (146); a microcontroller (at least microcontroller 170b) coupled to the docking station serial bus, and wherein the microcontroller is configured to communicate across the communication pathway (I2C) to determine whether the notebook computer is compatible with the docking station. With regard to claim 8, the computer system further comprising: a read only memory device (ROM 126) coupled to the second bridge logic device of the notebook computer; a serial electrically programmable read only memory device (EPROM) or (EEPROM 151 in Lin et al.) coupled to the docking station serial bus; wherein the input/output device of the notebook computer is further adapted to read information from the serial EPROM (151) across the docking station serial bus as part of determining whether the docking station is compatible with the notebook computer; and wherein the microcontroller of the docking station is further adapted to read information from said notebook computer ROM (126) across the notebook computer serial bus as part of determining whether the notebook computer is compatible with the docking station. With regard to claim 9, the notebook computer serial bus has a plurality of conductors (see Fig. 2); the secondary

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expansion bus having a plurality of conductors; a plurality of electrically controlled switches (113, for example) coupled one each between the docking connector and each of the plurality of conductors of the serial bus and the secondary expansion bus; and the input/output device (124) having a plurality of digital output signals coupled to the plurality of electrically controlled switches (113), the output signals configured to selectively activate the plurality of electrically controlled switches. With regard to claim 10, the input/output device (124) is configured to activate the digital output signals coupled to the electrically controlled switches of the serial bus (I2C) to allow the notebook computer (L) and the docking station (E) to communicate when determining whether the notebook computer and the docking station are compatible (see above). With regard to claim 11, the input/output device (124) is configured to activate the digital output signals coupled to the electrically controlled switches (113) of the secondary expansion bus after a determination that the notebook computer and docking station are compatible. With regard to claim 12, it is clear that one using the device of Lin et al. would have performed the same steps set forth in claim 12. See also further explanation provided under "Response to Arguments." With regard to claims 29-37, it is clear that one using the device of Lin et al. would have performed the same steps set forth in claims 1-11 and 24-28. See also further explanation provided under "Response to Arguments."

Response to Arguments

Applicants' arguments filed 2/3/2004 have been fully considered but they are not persuasive.

At the outset, Applicants are reminded that claims subject to examination will be given their broadest reasonable interpretation consistent with the specification. *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997). In fact, the "examiner has the duty of police claim language by giving it the broadest reasonable interpretation." *Springs Window Fashions LP v. Novo Industries, L.P.*, 65 USPQ2d 1862, 1830, (Fed. Cir. 2003). Applicants are also reminded that claimed subject matter not the specification, is the measure of the invention. Disclosure contained in the specification cannot be read into the claims for the purpose of avoiding the prior art. *In re Sporck*, 55 CCPA 743, 386 F.2d, 155 USPQ 687 (1986).

With this in mind, the discussion will focus on how the terms and relationships thereof in the claims are met by the references. Response to any limitations that are not in the claims or any arguments that are irrelevant and/or do not relate to any specific claim language will not be warranted.

The Lin et al. 35 USC 102 Rejection:

With regard to claim 1, Applicants argued that Lin et al. fails to teach or fairly suggest "wherein the docking station communicates across the communication pathway to determine whether the notebook computer is compatible with the docking station." Contrary to Applicants' argument, when the laptop L is docked, the MSIO-L

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124a, MSIO 124b are coupled by an a standard I2C bus 149. The inter-integrated circuit or I2C bus 149 is a simple bidirectional two wire bus used to provide efficient control and identification functions between integrated circuitry. Briefly, the I2C bus 149 consists of two lines: a serial clock line (SCL) and a serial data line (SDA). Each of these lines is bidirectional. The SCL line provides the clock signal for data transfers which occur over the I2C bus. The SDA line is the data line for data transfers which occur over the I2C bus. Each device connected to the I2C bus is recognized by a unique address. Both MSIO-L 124a and MSIO-E 124b incorporate an I2C interface 174a and 174b capable of serving as either a master or slave on the I2C bus 149. According to the I2C bus specification, in order to begin communication, the bus master places the information/address of the device with which it intends to communicate (the slave) on the bus. Only the device with the correct information/address communicates with the master. Also, according to Lin et al., the Laptop L/Docking Station E ascertain the intelligence of one another to check compatibility of softwares, for example. It is inherent that the user supplied with the information on compatibility will ultimately decide whether to update the softwares. Thus, it is clear that when the docking station E (comprising MSIO-E 124b) acts as a master, it must place the information/address of the device with which it intends to communicate (the laptop L comprising MSIO-L 124a) on the bus. The Laptop L must have a correct information/address in order to communicate with the docking station E. In another word, the docking station E must determine by checking the correct information/address of the Laptop whether the Laptop L is "compatible." Furthermore,

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in Lin et al., the laptop L and the docking station E must perform “hand-shaking” before data transfers. That is compatibility must be established both way between the laptop L and the docking station E before data transfers.

With regard to claim 12, Applicants argued that Lin et al. does not disclose “transferring information about software.” The Examiner disagrees. As pointed out in the 35 USC 112, 2nd paragraph, “transferring information about software” is understood as “software executed” as described by the specification. Thus, it is clear that in Lin et al., a determination on the “at least partially compatibility” between the laptop L comprising MSIO-L 124a and docking station E comprising MSIO-E 124b is “software executed.” See also explanation regarding to claim 1 above.

With regard to claim 13, the rejection of claim 13 is hereby withdrawn in view of Applicants’ amendment and argument.

With regard to claims 27 and 28, the rejection of claim 27 is hereby withdrawn in view of Applicants’ amendment and argument.

With regard to claim 29, Applicants argued that “Lin fails to fairly teach or suggest that the docking station could or should have a vote in determining whether to couple the secondary expansion bus of the notebook computer to the expansion bus of the docking station.” Contrary to Applicants’ argument, it is clear from Lin et al. that when the docking station E (comprising MSIO-E 124b) acts as a master, it must place the information/address of the device with which it intends to communicate (the laptop L comprising MSIO-L 124a) on the bus. The Laptop L must have a correct information/address in order to communicate with the docking station E. In another

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word, the docking station E must determine by checking the correct information/address of the Laptop whether the Laptop L is "compatible." Furthermore, in Lin et al., the laptop L and the docking station E must perform "hand-shaking" before data transfers. That is compatibility must be established both way between the laptop L and the docking station E before data transfers.

With regard to claim 35, Applicants argued that "Lin fails to fairly teach or suggest the docking station could or should have a vote in determining whether to couple the secondary expansion bus of the notebook computer to the expansion bus of the docking station." It is first noted that the language of claim 35 does not require that "the docking station could or should have a vote in determining whether to couple the secondary expansion bus of the notebook computer to the expansion bus of the docking station." Claim 35 only requires a determination from the notebook to check whether the docking station is compatible with the notebook. In any event, it is clear from Lin et al. that when the docking station E (comprising MSIO-E 124b) acts as a master, it must place the information/address of the device with which it intends to communicate (the laptop L comprising MSIO-L 124a) on the bus. The Laptop L must have a correct information/address in order to communicate with the docking station E. In another word, the docking station E must determine by checking the correct information/address of the Laptop whether the Laptop L is "compatible." Furthermore, in Lin et al., the laptop L and the docking station E must perform "hand-shaking" before data transfers. That is compatibility must be established both way between the laptop L and the docking station E before data transfers.

Allowable Subject Matter

Claims 27 and 28 are allowed.

Claims 13-18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

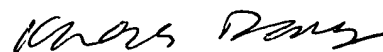
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication should be directed to Khanh Dang at telephone number 703-308-0211.

A handwritten signature in black ink, appearing to read "Khanh Dang", written in a cursive style.

Khanh Dang
Primary Examiner